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EXAMINER

PARSLEY, DAVID J

ART UNIT

PAPER NUMBER

3643

DATE MAILED: 04/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/892,486

Applicant(s)

D'AGNONE ET AL.

Examiner

David J Parsley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **Detailed Action**

### ***Amendment***

1. This office action is in response to applicant's amendment (paper no. 9) dated 11-13-02 and this action is non-final.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-13, 15-16, 20, 22-24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by DE Patent No. 3834812 to Baumli.

Referring to claim 10, Baumli discloses a paper product comprising first and second paper sheets each having first and second opposite paper surfaces with the first paper surfaces being in substantially planar contiguous surface-to-surface opposing relationship at both major – 1 and minor – 7 opposing surface area portions thereof, the major opposing surface area portions of the first and second paper sheets first paper surfaces being adhesively bonded to each other, a line of perforations – 8 in the first and second paper sheets which is adapted to be torn to facilitate the separation of the major – 1 and minor – 7 opposing surface area portions from each other, and a germinative seed – S housed between the minor opposing surface area portions

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which minor opposing surface area portions and the germinative seed housed therein can be subsequently planted absent adversely affecting damaging or destroying the major opposing surface area portions – see for example figures 5-6 and columns 1-3.

Referring to claim 11, Baumli discloses the line of perforations – 8 is a substantially continuous line of perforations – see for example figures 5-6.

Referring to claims 12 and 23, Baumli discloses the line of perforations has opposite ends – see for example figures 5-6.

Referring to claims 13 and 24, Baumli discloses the line of perforations extend substantially between edges of the sheets – see for example figures 5-6.

Referring to claims 15 and 26, Baumli discloses the line of perforations – at 8 is a substantially continuous closed line of perforations – see for example figures 5-6.

Referring to claim 16, Baumli discloses the minor opposing surface area portions – 7 of the first and second paper sheets first paper surfaces are adhesively bonded to each other – see for example figures 5-6 where the minor opposing surface area portions are adhesively bonded to one another along the side and bottom portions of the packet - 1.

Referring to claim 20, Baumli discloses the major opposing surface area portion provides means for defining an inscription field – see for example figures 1-6 and columns 1-3.

Referring to claim 22, Baumli discloses the line of perforations – at 6 or 8 is a substantially continuous line of perforations – see for example figures 1-6.

***Claim Rejections - 35 USC § 103***

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumli as applied to claims 10 and 16 above, and further in view of Baumli or Tanato. The embodiment of Baumli as shown in figures 5-6 does not disclose the line of perforations extend substantially between opposite edges of the sheets. The embodiment of Baumli as seen in figures 1-3 and Tanato do disclose the line of perforations – at 6 of Baumli and – at 64 and 84 of Tanato, extend substantially between opposite edges of the sheets. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli and add the line of perforations extending between opposite ends of the sheets of Baumli or Tanato, so as to allow for the paper sheets to be easily separated and thus quicker and easier to use.

Claim 15 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumli as applied to claims 10 and 16 above, and further in view of U.S. Patent No. 4,027,340 to Hadtke. Hadtke does disclose the line of perforations – 22 and 24 is a substantially continuous closed line of perforations – see for example figure 1. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli and add the line of perforations being a closed continuous line of Hadtke, so as to allow for the perforated section to be removed from the paper product while not damaging the non-perforated portion of the paper product.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumli as applied to claim 10 above, and further in view of U.S. Patent No. 5,860,245 to Welch. Baumli further discloses an adhesive bonds the major opposing surface area portions to each other – see for example figures 5-6. Baumli does not disclose the adhesive is decomposable. Welch does disclose the adhesive is decomposable – see column 3 lines 3-10. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli and add the decomposable adhesive of Welch, so as to make the paper product more effective in promoting the plant seed to grow since the adhesive is decomposable and environmentally friendly and thus won't harm the growth of the seed into a plant.

Claims 18 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumli as applied to claims 10 and 16 above, and further in view of U.S. Patent No. 4,168,002 to Crosby. Baumli does not disclose a means for indicating the presence of the germinative seed between the minor opposing surface area portions. Crosby does disclose a means – see column 3 lines 44-52 for indicating the presence of the germinative seed between the minor opposing surface area portions – 17 and 18. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli and add the means for indicating the presence of the seed of Crosby, so as to allow for one to verify the seed is between the minor surface area portions of the paper product without damaging the paper product.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumli as applied to claim 10 above, and further in view of U.S. Patent No. 4,838,580 to Tuhkanen or U.S. Patent No. 5,158,809 to Proctor or WO Patent No. 94/00975 to Poret. Baumli does not disclose the major opposing surface area portion provides means for defining an address field. Tuhkanen,

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Proctor and Poret do disclose the major opposing surface area portion – 6f of Tuhkanen, - 13 of Proctor and – 16 of Poret provides means for defining an address field– see for example figures 1-8 and column 2 lines 60-65 of Tuhkanen, figures 1-2 of Proctor and figure 1 of Pore. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli and add the major surface areas with address field of Tuhkanen, Proctor or Poret, so as to make the paper product more user friendly since the address field won't be interfered with as the seed grows into a plant, thus allowing the user to be able to read the address field at all times.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumli as applied to claim 10 above, and further in view of U.S. Patent No. 4,418,497 to Mastriano or U.S. Patent No. 5,062,229 to Werjefelt. Mastriano and Werjefelt do disclose the major opposing surface area portion provides means for defining an inscription field – 36 of Werjefelt and – 14 of Mastriano. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli and further add the means for defining an inscription field of Mastriano or Werjefelt, so as to make the paper product more visually pleasing in that inscriptions can be placed onto the paper product.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumli as applied to claim 10 above, and further in view of U.S. Patent No. 5,062,229 to Werjefelt. Baumli does not disclose the major opposing surface area portion provides means for defining a calendar field. Werjefelt does disclose the major opposing surface area portion provides means for defining a calendar field – 30 – see for example figures 1-5. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli and add the major surface area portion providing means for defining a calendar field of Werjefelt, so as to allow for

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the paper product to not be wasted and immediately discarded in that the calendar can be used throughout the year.

Claims 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumli in view of Werjefelt.

Referring to claim 28, Baumli discloses a paper product comprising first and second paper sheets each having first and second opposite paper surfaces with the first paper surfaces being in substantially planar contiguous surface-to-surface opposing relationship at both major – 1 and minor – 7 opposing surface area portions thereof, the major – 1 opposing surface area portions of the first and second paper sheets first paper surfaces of each pair being substantially permanently adhesively bonded to each other, a line of perforations – 8 in the first and second paper sheets which is adapted to be torn to facilitate the separation of the major – 1 and minor – 7 opposing surface area portions from each other, a germinative seed – S housed between the minor – 7 opposing surface area portions of each pair which minor opposing surface area portions and the germinative seed housed therein can be subsequently planted absent adversely affecting, damaging or destroying the major opposing surface area portions – see for example figures 5-6.

Baumli does not disclose a plurality of pairs of first and second paper sheets. Werjefelt does disclose a plurality of pairs of first and second paper sheets – 24 and 26 – see for example figures 1-2. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli and add the plurality of pairs of paper sheets of Werjefelt, so as to allow for the device to be more efficient and cost effective in that multiple quantities of seeds to be transported and subsequently planted by the user.



Baumli further does not disclose a means for connecting the pairs of paper sheets together. Werjefelt does disclose a means – 5,6,7 for connecting the pairs of paper sheets – 24 and 26 together – see for example figures 1-2. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli and add the means for connecting the pairs of sheets together of Werjefelt, so as to allow one to carry the plurality of sheets together as a whole without damaging or losing any of the sheets.

Referring to claim 29, Baumli as modified by Werjefelt further discloses the connecting means – 5,6,7 are located along a common edge of the pairs – 24 and 26 – see for example figures 1-2 of Werjefelt. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli as modified by Werjefelt and further add the connecting means located along a common edge of the pairs of Werjefelt, so as to allow for the paper product to be easily manufactured in that the connecting means are located on only one edge of the paper product.

Referring to claim 30, Baumli as modified by Werjefelt further discloses each of the pairs – 24 and 26 defines a calendar field – 30 – see figures 1-2 of Werjefelt. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli as modified by Werjefelt and add the pairs defining a calendar field of Werjefelt, so as to allow for the paper product to not be wasted and immediately discarded in that the calendar can be used throughout the year.

Referring to claim 31, Baumli as modified by Werjefelt further discloses each of the pairs defines a calendar field – 24 and a post card field – 26 set-off by each line of perforations – 22 – see for example figures 1-2 and column 3 lines 25-50 of Werjefelt. Therefore it would have been

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obvious to one of ordinary skill in the art to take the paper product of Baumli as modified by Werjefelt and add the pairs defining a calendar field and a post card field of Werjefelt, so as to allow for the paper product to be flexible in that it has many uses.

Referring to claim 32, Baumli as modified by Werjefelt further discloses each line of perforations – 22 extends substantially between opposite edges of each of the pairs – 24 and 26 – see for example figures 1-2 of Werjefelt. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli as modified by Werjefelt and add the line of perforations extending between opposite edges of the pairs of Werjefelt, so as to allow for the perforated portion to be quickly torn and removed since the line of perforations extends between two opposite edges of the paper product.

#### ***Response to Arguments***

4. Regarding claims 10 and 28, the claim as written states the “...minor opposing surface area portions and the germinative seed housed therein can be subsequently planted...” The claim does not state that the minor surface area portions are definitively planted with the seeds but only that they can be planted which means that the minor surface area portions as claimed do not have to be planted with the seeds. Further the Baumli reference states that the seed packet can be planted into the ground along with the seeds and it is inherent that the minor opposing surface area portions can be planted since they are part of the seed packet.

Regarding claim 15, the Hadtke reference does disclose a mask, but the mask is made of paper and as seen in the claims what is claimed is a paper product. The Hadtke reference

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discloses a paper product with perforations as does the Baumli reference and therefore the references are analogous and can be combined as stated above to render the claim obvious.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding claims 16 and 22, the arguments are rendered moot in view of the new grounds of rejection as stated above in paragraph 2 of this office action which were necessitated by the amendment.

Regarding claim 17, it makes sense to use a decomposable adhesive in the Baumli device since as stated before and in columns 1-3 of Baumli the seed packet is planted in the soil and thus a decomposable adhesive is desirable so as to not harm the environment and the seeds which were recently planted.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding claims 18-20, the subject matter of claim 10 is rendered not novel as stated above in paragraph 2 of this office action and therefore the rejections using the Crosby and Tuhkanen references in combination with the Baumli reference are valid and justified.

Regarding claim 21, the Baumli reference discloses that an indicia can be placed on the paper product and the Werjefelt discloses that an indicia being a calendar can be placed on a paper product and thus since the Baumli reference teaches that an indicia can be placed on the paper product it renders the claim obvious in combination with the Werjefelt as stated above. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding claims 28-32, as stated above the Baumli and Werjefelt reference are analogous and as further stated above it would be obvious to take the Baumli device and have multiple paper products connected together, so as to allow for more seeds to be transported and subsequently planted by the user thus making the device more efficient.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

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obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion or motivation to combine the Baumli and Werjefelt references is found in the knowledge generally available to one of ordinary skill in the art. Attaching multiple paper products together allows for easier transporting of the product in higher quantities.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to paper products containing seeds in general:

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U.S. Pat. No. 3,908,308 to Meyers – shows seed in paper product to be planted

U.S. Pat. No. 4,080,755 to Crosby – shows seed in paper product

U.S. Pat. No. 4,442,627 to Adams et al. – shows seed in product to be planted

U.S. Pat. No. 4,453,369 to Estkowski – shows paper product with seeds


U.S. Pat. No. 5,720,129 to Lantinberg – shows paper product with seeds

JP Pat. No. 9-104188 to Miyano – shows paper product with seeds

JP Pat. No. 9-298912 to Watari – shows paper product with seeds to be planted

6. Any inquiry concerning this communication from the examiner should be directed to David Parsley whose telephone number is (703) 306-0552. The examiner can normally be reached on Monday-Friday from 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon, can be reached at (703) 308-2574.

  
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